



Patent
Attorney Docket No. 032326-073

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Stephane Rayon et al.

Application No.: 09/601,111

Filing Date: July 27, 2000

Group Art Unit: 2876

Examiner: Ahshik Kim

Confirmation No.: 5591

Title: MICROPROCESSOR CARD INCLUDING A CABLE COMMUNICATION CIRCUIT

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per
Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the
☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered.
Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____

on _____
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____,
which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R.
§ 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also
enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	8	MINUS 20 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	1	MINUS 3 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
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(703) 836-6620

Date: July 7, 2004

By 
James A LaBarre
Registration No. 28,632



Patent
Attorney's Docket No. 032326-073

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Pascal CORREMAN et al.)	Group Art Unit: 2876
Application No.: 09/601,111)	Examiner: Ahshik Kim
Filed: July 27, 2000)	Confirmation No.: 5591
For: MICROPROCESSOR CARD)	
INCLUDING A CABLE)	
COMMUNICATION CIRCUIT)	

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated April 7, 2004, Applicants respectfully request reconsideration of the rejection of the claims. The withdrawal of the previous ground of rejection is noted with appreciation.

Claims 1 and 6-8 were rejected under 35 U.S.C. §103, on the grounds that they were considered to be unpatentable over the previously applied Kim et al. and Anderl et al. patents, in view of the newly-cited Kimura patent. In essence, the Office Action repeats the previous ground of rejection, based upon the Kim and Anderl patents, but then states that these two patents do not teach that the components performing the security/error check are in the form of a hard-wired circuit. To this end, the Office Action refers to the Kimura patent, which discloses a security control circuit for a memory card, that is in the form of hard-wired logic elements that do not require a programmed microprocessor. The Office Action concludes that it would be

obvious to modify the structure of a smart card, in light of this teaching, to hard-wire the security components of the card.

It is respectfully submitted that the Kimura patent does not overcome the distinctions between the presently claimed subject matter and the teachings of the Kim and Anderl patents, which were pointed out in Appellants' Brief filed November 28, 2003. First, it is noted that the reliance upon the Kimura patent is based upon the statement that the Kim and Anderl patents do not suggest that the components performing the error check can be in the form of a hard-wired circuit. However, the I/O interface shown in Figure 3 of the Kim patent can be considered to be a hard-wired circuit, consisting of three registers 31-33 and two logic circuits 34-35. Accordingly, it is respectfully submitted that there would be no reason for a person of ordinary skill in the art to modify the disclosure of the Kim patent in view of the Kimura patent, since the Kim patent already teaches the subject matter for which the Kimura patent is being relied upon.

Second, it is further submitted that it would not be obvious to refer to the teachings of the Kimura patent, because it is directed to a problem that is totally distinct from the smart card technology to which the Kim patent pertains. More particularly, the background portion of the Kimura patent explains that portable semiconductor memory devices fall into two classes, namely "smart cards" which have a microprocessor in addition to a main storage unit, and "memory cards" which have only a memory, but no programmable microprocessor. (Col. 1, lines 12-17). This portion of the patent goes on to explain that the on-board microprocessor of a smart card provides numerous security techniques that can be employed to protect the integrity of data stored on the card. In contrast, however, since memory cards do

not have an on-board microprocessor, they are much more vulnerable to security transgressions, because the data, address and control lines of the memory modules can be directly accessed via the card contacts. (Col. 1, lines 18-22 and 30-38). The Kimura patent is specifically directed to memory cards that do not have an on-board microprocessor unit. See, for example, column 3, lines 58-63. The problem to which the Kimura patent is directed does not apply to smart cards having on-board microprocessors, such as the card of the Kim patent. For this additional reason, therefore, it would not be obvious for a person of ordinary skill in the art to apply the teachings of the Kimura patent to the smart card of the Kim patent.

Third, and perhaps most significantly, even if the teachings of the Kimura patent could somehow be applied to the Kim smart card to employ a hard-wired security control circuit for the data in the memory of the card, the result would still not be the same as the presently claimed invention. As pointed out in greater detail in Appellants' Brief, the Kim et al. patent does not disclose that the I/O interface device 30 functions to "generate and return at least one item of information to the terminal which is a function of the signals received," as recited in claim 1. Rather, in the smart card of the Kim patent, the only information that is generated as a function of the signals received, namely the signal PBT, is sent to the card's CPU, rather than returned to the terminal. Furthermore, the rejection has not identified any teaching in the Anderl patent which would lead a person of ordinary skill in the art to modify this type of operation. The Office Action notes that the Anderl patent teaches that a *card* can transmit data in response to an integrity signal that is received from a terminal. However, there is no teaching in the patent that the card's interface circuit, as opposed to its microprocessor, generates and transmits such a response.

Accordingly, there is no teaching in either the Kim patent or the Anderl patent that would lead one of ordinary skill in the art to the claimed subject matter. Nor is there any teaching in the Kimura patent to this effect.


For at least these three reasons, therefore, it is respectfully submitted that the teachings of the Kim, Anderl and Kimura patents, even when considered in combination, do not suggest a card having a communication device of the type recited in claim 1.

In addition to the foregoing distinction, Appellant's Brief also pointed out that claim 8 recites additional subject matter which further distinguishes it from the references, and supports separate patentability of that claim. It is noted that the most recent Office Action does not address the arguments pertaining to claim 8. It is not apparent from the Office Action how the references are being interpreted with respect to the specific subject matter recited in this claim. If the rejection is not withdrawn, the Examiner is respectfully requested to explain, with particularity, where the subject matter recited in claim 8 can be found in the teachings of the references.

For the foregoing reasons, it is respectfully submitted that all pending claims are allowable over the prior art of record. Reconsideration and withdrawal of the rejection is respectfully requested.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 7, 2004

By: 
James A. LaBarre
Registration No. 28.632

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